

REMARKS

Reconsideration of the above-identified application as amended is requested. Claims 11-28 are pending in the instant application. Claims 1-10 have been cancelled without prejudice or disclaimer and new claims 11-28 introduced. Support for these amendments can be found throughout the specification. For example the compounds recited in claims 11-16 are the compounds exemplified in the Examples of the specification. The specification has been amended to provide the correct IUPAC name for the compound of Example 75. Support for the amended IUPAC name is provided by the chemical structure on page 82. No new matter has been introduced by the instant amendments.

Claims 1, 2, and 5-9 stand rejected under 35 U.S.C. 112, second paragraph, as being allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 2, and 5-9 have been cancelled in this paper. New claims 11-28 obviate the instant rejections.

Claim 6 stands rejected under 35 U.S.C. §101 allegedly because the claimed recitation of a use, without setting forth any steps involved in a process, results in an improper definition of a process.

Claim 6 has been cancelled. New method of treatment claims 17-22 include an affirmative process step and are therefore in compliance with §101.

Claims 6-8 stand rejected under 35 U.S.C. §112, first paragraph, because the specification, while being enabling for the treatment of osteoporosis (various types) and osteopathy, does not reasonably provide enablement for the other disorders.

Claims 6-8 have been cancelled. New method of treatment claims 17-22 are directed to various forms of osteoporosis, osteopathy and fractures. Thus, new claims 17-22 are fully compliant with the requirements of §112, first paragraph.

Claims 1, 2, and 8 stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 25, 32, and 34 of USSN 10/480,559 (recently allowed).

Claims 1, 2, and 8 have been cancelled in the instant amendment. New claims 11-16 provide specific compounds which were not disclosed in the '559 application. Thus, the double patenting rejection has been obviated.

Claims 1, 2, 5 and 8 stand rejected under 35 U.S.C. §102(b) as being anticipated by Masai, et al (Chem. Pharm. Bull., Vol. 25 (1977), pp 2018-3022). See compounds 3 through 12 on page 2018.

Claims 1, 2, 5 and 8 have been cancelled by the instant amendment. None of the compounds of claim 11 are disclosed or suggested in the Masai reference.

Claims 1, 2, 5 and 8 stand rejected under 35 U.S.C. §102(b) as being anticipated by Gamboni, et al (US 4,236,006). See column 3, Example 3, compound (a).

Claims 1, 2, 5 and 8 have been cancelled by the instant amendment. None of the compounds of claim 11 are disclosed or suggested in the Gamboni patent.

Claims 1, 2, 5 and 8 stand rejected under 35 U.S.C. §102(b) as being anticipated by Yamamoto, et al (US 4,202,974). See, column 3, compounds on line 19 and 26.

Claims 1, 2, 5 and 8 have been cancelled by the instant amendment. None of the compounds of claim 11 are disclosed or suggested in the Yamamoto patent.

Claims 1, 2, 5 and 8 stand rejected under 35 U.S.C. §102(b) as being anticipated by Yamamoto, et al (US 4,387,223). See, column 4, compound on line 5 (i.e., the third compound on column 4).

Claims 1, 2, 5 and 8 have been cancelled by the instant amendment. None of the compounds of claim 11 are disclosed or suggested in the Yamamoto patent.

Thus, claims 11-16 are patentable over any of the documents forming the basis of the §102(b) rejections in the pending office action.

In view of the above, it is respectfully submitted that all of the claims are in condition for allowance. Early action to that end is respectfully requested. The Examiner is hereby invited to contact the undersigned by telephone if there are any questions concerning this amendment or application. The Commissioner is hereby authorized to charge any additional fees under 37

CFR §1.17 which may be required, or credit any overpayment, to Account No. 19-0134 in the name of Novartis.

Respectfully submitted,

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